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09/369,502	08/05/1999	FOROUGH KASHEF	VISAP018/P10	6864

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EXAMINER

KIM, AHSHIK

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/369,502

Applicant(s)

KASHEF ET AL.

Examiner

Ahshik Kim

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2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 and 36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 and 36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Amendment*

1. Receipt is acknowledged of the amendment filed on June 4, 2003. In the amendment,  
5 claims 1, 21, 32, and 33 were amended. Currently, claims 1-34 and 36 remain for examination.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all  
obviousness rejections set forth in this Office action:

10 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in  
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are  
such that the subject matter as a whole would have been obvious at the time the invention was made to a person  
having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the  
manner in which the invention was made.

- 15 3. This application currently names joint inventors. In considering patentability of the  
claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various  
claims was commonly owned at the time any inventions covered therein were made absent any  
evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out  
20 the inventor and invention dates of each claim that was not commonly owned at the time a later  
invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)  
and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eaton  
25 et al. (US 6,012,050, of record), in view of Wilkinson et al. (WO 98/19237, of record).

Eaton teaches a transaction system that utilizes an ATM terminal 93, the system

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comprising an operating system and terminal hardware and an environmental services layer L4 that is dependent upon the operating system and/or hardware. The layers, labeled collectively as the Integrated Channel Manager 100, contains applications to select and activate environment dependent services 92-97, the applications independent from the hardware or operating system and allowing multiple channels to be accessed (see figures 2-4, col. 4, line 5 – col. 5, line 8).

The environmental dependent services may consist of any combination of structures, affording the possibility of identical structures. Interfaces 132, 134, 136 allow the applications to identify an environmental dependent services layer. A business logic layer (item 130 of figure 3) contains interfaces 122,124,126 and modules 142,144,146,148 that are responsible for executing business application commands and functions. Layer L6 provides services that enable peripheral devices to be accessed (col. 4, lines 66-67). Multimedia services can also be accessed, those including a user interface or printing means (col. 6, lines 27-34). The system may be used as a loyalty card service.

Eaton fails to teach the terminal application as compatible with a smart card, the card's information able to use different modules or applications, and the terminal application as portable to a plurality of terminals.

Wilkinson teaches using a smart card 10 to control communication with a terminal, the card being recognized and identified by the terminal application when presented to the card reader (see figure 13 and page 24, line 14 – page 25, line 4) and supplying applications to be used within the terminal. The card contains multiple card applications. The applications utilized may be provided by different companies using different terminals (page 6, line 33 – page 7, line 1). It would have been obvious to one of ordinary skill in the art to employ the use of the card

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with the system of Eaton. It is well known in the art to use cards to transport data from one card-reading terminal to another. The data containing different applications would afford the terminal of Eaton to become more versatile in the types of transactions it can handle. This also allows different terminals to employ similar applications, as the card would be readily portable and  
5 available to operate successfully with the terminal.

Although the teachings do not specify the business layer implementing business policies if the card is not recognized, it would have been obvious to employ such a feature within the system. Official Notice is taken that it is known in the art for terminals of financial institutions to implement features if, per se, the card of a user is not recognized. For instance, if a customer  
10 is trying access funds with the card at a terminal, but the card is not recognized, the terminal applications with enable certain business policies, such as asking for other types of account identifiers or penalizing an account for using an incorrect card.

### ***Response to Arguments***

15 5. The Applicants' amendment and remarks filed on June 4, 2003 have been carefully reviewed and considered, but they are not persuasive.

In the amendment, the Applicants amended claim 1 such that the claim now reads "A terminal for accepting a card that implements a card application .....a terminal application of the terminal compatible with the card application and having a platform independent portion that  
20 is independent of the hardware and operating system of the terminal, whereby the terminal application is developed independently of the hardware and operating system of the terminal, the platform independent portion including at least one of a stored value application, a credit

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application, a debit application, and a loyalty application”. Claims 21 and 32 were amended to include similar limitation, although not word by word identical to amended claim 1.

With added limitation, the Applicants traverses the rejection made in previous Office Action, and argues that the claims are patentable over Eaton in view of Wilkinson .

5           In response to the Applicants’ amendment and argument, the Examiner reviewed the Eaton patent and Wilkinson patent. Upon further review, however, it is still the Examiner’s view that Eaton in view of Wilkinson teaches on the subject matter disclosed in the amended claims.

Eaton teaches a transaction system comprising various terminals including card readers. The terminals communicate with an integrated channel manager (ICM) 100. The ICM contains  
10   channel interfaces for various terminals 122, 124, 126 (col. 3, lines 43+). The Wilkinson patent teaches a terminal and transaction system for smart cards, wherein the applications for smart card and the terminal are written in platform independent languages such as Java (page 15, lines 14+). Since the applications are written in Java, different terminals can be in the system where one terminal can load applications and other terminals can download and execute them.

15   Accordingly, Eaton in view of Wilkinson, teaches on “a terminal software application having a platform independent portion .....” presented in amended claims.

The amended claims and remarks describing these elements have been fully considered, but in view of the above, the rejection made in previous Office Action is maintained. Therefore, the Examiner has made this Office Action final.

20

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

I. The prior art made of record and not relied upon is considered pertinent to Applicants' disclosure: Lee et al. (US 6,018,717); Hohle (US 6,199,762); Korman et al. (US 6,308,887) disclose a smart card transaction system utilizing platform-independent software.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].


*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim  
Patent Examiner  
Art Unit 2876  
September 10, 2003



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